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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|------------------------|---------------------|------------------|
| 10/088,852 | 03/21/2002 | Andrew Austen Mortlock | ASZD-P01-600 | 2243 |
| 44992 | 7590 | 06/27/2005 | EXAMINER | |
| ASTRAZENECA R&D BOSTON 35 GATEHOUSE DRIVE WALTHAM, MA 02451-1215 | | | TRUONG, TAMTHOM NGO | |
| | | | ART UNIT | PAPER NUMBER |

1624

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,852

Applicant(s)

MORTLOCK ET AL.

Examiner

Tamthorn N. Truong

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-17 and 19-22 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's amendment of 5-31-05 has been fully considered. The amended claims have overcome the previous rejection of 112/1st paragraph, and thus, said rejection is withdrawn herein. However, applicant's argument has not overcome the 112/2nd rejection for claim 2. The previous objection is also withdrawn for claims 1-12, 14-17 and 19-22, but not for claim 18.

Furthermore, in light of applicant's argument on the antecedent basis for the phrase "*combination thereof*" in claim 2, it has been found that the scope of "*optionally substituted hydrocarbyl*" has indefinite metes and bounds.

Due to the following new ground of rejection and objection, the previous finality is withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-12, 14-17, and 19-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

a. Claims 1 and 2 recite the limitation of "*optionally substituted hydrocarbyl*", which has indefinite metes and bounds. First of all, the definition of "*hydrocarbyl*" includes *alkyl*, *alkenyl*, *alkynyl*, *aryl*, *aralkyl*, *cycloalkyl*, *cycloalkenyl* or *cycloalkynyl*, or

combination thereof. So, it is not clear how many rings or chains constitute a “hydrocarbyl”, or how the rings and/or chains are connected. The scope of “hydrocarbyl” could read on a polymer such as ‘polyethylene’, ‘polypropylene’, etc. Likewise, the limitation of “*optionally substituted hydrocarbyl*” could also read on ‘fatty acid’, ‘carbohydrate’, ‘polypropoxy’, ‘polyethoxy’, etc. The specification lists *optional substituents* for hydrocarbyl which include: “*halo, perhaloalkyl, ..., mercapto, thioalkyl, hydroxyl, carboxy, alkoxy, heteroaryl, heteroalkoxy, cycloalkyl, cycloalkenyl, cycloalkynyl, alkenyloxy, alkynyloxy, alkoxyalkoxy, aryloxy, ..., cyano, nitro, amino, mono- or di-alkyl amino, oximino or S(O)₂R⁹⁰ ...*” However, the twenty-two groups defined for R¹⁶ include an *alkylene, alkenylene, or alkynylene* substituted with such as: carboxamide, sulfonamide, C(O)ONR²⁹, etc. which are not among the substituents listed for “*optionally substituted hydrocarbyl*”. Thus, the scope of “*optionally substituted hydrocarbyl*” does not have proper metes and bounds.

b. Claims 5 and 6 lack antecedent basis because they depend on claim 1, but the definition of R¹⁶ includes twenty-two groups that are not within the scope of “*optionally substituted hydrocarbyl*” (as defined on page 5 of the specification). Claims 10, 11 and 16-22 are rejected as being dependent on claim 6.

c. Claims 1 and 7 recite the limitation of “*ester or amide thereof*”. However, many of the substituents are already an ester or amide (e.g., moieties defined for R¹-R⁴), thus it is unclear if another ester or amide is intended. It is also unclear where the additional ester or amide is.

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- d. Claims 3-6, 8, 9, 12, 14 and 15 are rejected as being dependent on claim 1 or 7.

Claim Objections

2. Claim 18 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must refer to preceding claims in an alternative language. See MPEP § 608.01(n). Accordingly, the claim 18 has not been further treated on the merits. Note, claim 18 still refers to both claims 6 and 16.

Specification

3. The disclosure is objected to because of the following informalities: Page 6, line 3, there are two commas after the word *heteroaryloxy*.

Appropriate correction is required.

References cited on PTO-892


4. An update search yields a reference of **Gazit et. al.** (WO 2004/013091 A2) which teaches relevant compounds. However, its publication does not antedate the effective filing date of this application, and thus, it is not a competent prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 571-272-0676. The examiner can normally be reached on M-F (9:30-6:00).

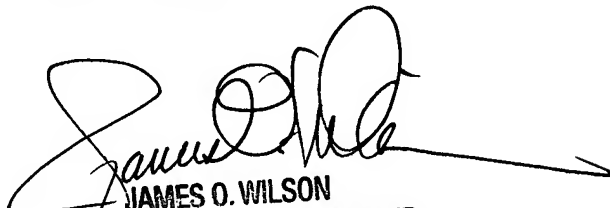
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Tamthom N. Truong
Examiner
Art Unit 1624

6-13-05


JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
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